

REMARKS/ARGUMENTS

Prior to entry of this Amendment, claims 9-15 and 19-21 were pending in this application. Claim 19 has been amended, claims 22-27 have been added and previously withdrawn claims 1-9 have been canceled herein. Therefore, claims 9-15 and 19-27 are now pending in this application. Applicants respectfully request reconsideration of these claims for at least the reasons presented below.

35 U.S.C. §103 Rejection, Inoue

The Final Office Action has rejected claims 9-15 and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,729,280 to Inoue et al. (hereinafter "Inoue"). The Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicants request reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, the Office Action must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP § 706.02(j). However, as will be discussed below, the reference cited by the Office Action does not teach or suggest each claimed limitation.

Inoue "relates to a video signal receiver for a near video-on-demand broadcast system." (Column 1, lines 7-8) In one embodiment of Inoue, "the near video-on-demand signal receiver pre-stores the first segment of a desired video program in the buffer memory apparatus." (Column 8, lines 35-38) "When a user requests reception and display of the video program, the pre-recorded segment is immediately reproduced and displayed while the receiver scans the channels carrying the program for the remaining segment of the program." (Column 8, lines 38-

42) "Once a transmission of the remaining segment is found, the corresponding video signals are received, stored, reproduced, and displayed." (Column 8, lines 42-44)

That is, Inoue teaches storing a portion of a requested program that can be played out while remaining portions of the program are located and received. As noted in Inoue, "by storing a portion of a selected video program, the receiver can display the stored portion of the program while awaiting or receiving transmission from the broadcaster of a subsequent portion of the program." (Col.3, lines 60-63) However, Inoue does not teach or suggest storing a first segment of each of a plurality of programs. In other words, Inoue does not teach or suggest storing the first segment of all of a plurality of programs.

It is noted that the final Office Action cites col. 8, lines 35-62 of Inoue to demonstrate a teaching or pre-recording a first segment of a program. However, a careful reading of this portion of Inoue reveals that not all first segments are stored. Rather, only selected first segments are stored under Inoue. Specifically, Inoue states:

"For example, the microcomputer may automatically initiate recording of the program segment from a broadcast signal at a predetermined time. Alternatively, the first segment may be supplied to the buffer memory apparatus 12 via a discrete memory device, such as a cartridge, which is removably coupled to the device. As another alternative, a user might direct that one or more initial segments of different programs be prerecorded in anticipation of viewing one of those programs at a later date." (Col. 8, lines 49-57)

That is, Inoue teaches storing a program that is selected in some way such as identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory device, programming the device to record the program, etc.

Furthermore, the final Office Action contends that "although Inoue does not explicitly teach determining if any of a first segment of each of a plurality of programs sent from the content provide before any user request for any of the plurality of programs are not already stored, it would have been obvious to one of ordinary skill in the art to determine if any of a first segment of a program is not already stored and recording a segment that is not already stored

because doing so will allow only segments that are needed to be recorded, thus saving storage space." (Office Action page 3-4) The Applicants respectfully submit that this stated motivation would actually prevent one skilled in the art from modifying Inoue to store all first segments since storing only selected first segments rather than all first segments would conserve more storage space.

Claim 9, upon which claims 10-15 and 22-24 depend, recites in part "determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored; recording any first segment of each of the plurality of programs that are not already stored." However, Inoue does not teach or suggest determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored and recording any first segment of each of the plurality of programs that are not already stored, i.e., recording all first segments. Rather, Inoue teaches pre-recording only selected first segment based on identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory device, programming the device to record the program, etc. (Column 8, lines 47-57.) For at least these reasons, the rejection should be withdrawn and claims 9-15 and 22-24 should be allowed.

Claim 19, upon which claims 20, 21, and 25-27 depend, recites in part "recording a first segment of all of a plurality of programs sent from the content provider before any user request for the program." However, Inoue does not teach or suggest recording a first segment of all of a plurality of programs sent from the content provider before any user request for the program. Rather, Inoue teaches pre-recording only selected first segment based on identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory device, programming the device to record the program, etc. (Column 8, lines 47-57.) For at least these reasons, the rejection should be withdrawn and claims 19-21 and 25-27 should be allowed.

The dependent claims are thought to be allowable for additional reasons. For example, claims 22 and 25 are thought to allowable at least for the additional reason that Inoue does not teach or suggest wherein the first segment of each of the plurality of programs is sent from the content provider once. Claim 23 and 26 are thought to allowable at least for the additional reason that Inoue does not teach or suggest wherein the first segment of each of the plurality of programs are sent from the content provider on the same channel. Claim 24 and 27 are thought to allowable at least for the additional reason that Inoue does not teach or suggest wherein the second segment of the one of the plurality of programs is sent from the content provider more than once and on more than one channel.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Date: October 10, 2007

/William J. Daley/
William J. Daley
Reg. No. 52,471

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834
Tel: 303-571-4000 (Denver office)
Fax: 303-571-4321 (Denver office)

WJD/jep

61153372 v1